

### **REMARKS**

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which applicants regard as the invention.

By this Amendment "C", independent claims 5 and 19 have been amended. No claims have been canceled and new claims or matter has been added to the application. Accordingly, claims 5-10 and 19-21 are pending in the application.

In the prior Office Action, the Examiner rejected claim 19 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner noted that there was insufficient antecedent basis for the limitation "said front wheel and/or said rear wheels" in line 7 of claim 19. By this Amendment "C", claim 19 has been amended to provide antecedent basis for such limitation. Accordingly, reconsideration of the rejection of claim 19 under 35 U.S.C. §112, second paragraph, is respectfully requested.

Also in the prior Office Action, the Examiner rejected claims 5-9 and 19-21 under 35 U.S.C. §103(a) as being unpatentable over Matsuzaka, JP 2000-325671, Patch, U.S. Pat. No. 5,203,733, and Fors, U.S. Pat. No. 3,462,148. For the reasons set forth below, applicants respectfully request reconsideration of the claim rejections.

The play toy system claimed in claim 5 includes a traveling toy having three wheels, specifically one front wheel and two rear wheels. Claim 5 further specifies that in the three-wheel traveling toy, the diameter one of the rear wheels is different

than the diameter of the other rear wheel. Claim 5 further specifies that the play toy system uses a play board having a circular inclined surface with a concave section formed in a central portion thereof. And, claim 5 specifies that the concave section in the central portion of the play board has a size capable of fully receiving the front wheel and/or rear wheels of the traveling three-wheeled toy and a depth allowing the remote-controlled traveling toy to get out of there by itself.

Applicants respectfully submit that the prior art references relied upon by the Examiner to reject claim 5 cannot be combined in such a way as to arrive at a play toy system that includes all of the elements of the play toy system as claimed in amended claim 5. The primary reference relied upon by the Examiner, Matsuzaka, discloses a remote-controlled four-wheeled traveling toy having two front wheels and two rear wheels wherein the diameter sizes of the rear wheels are different. And unlike the three-wheeled traveling toy claimed in claim 5, Matsuzaka's four-wheel traveling toy is not designed to travel on a play board having a circular inclined surface. As described in the English language abstract of Matsuzaka, the diameter sizes of the rear wheels are different in order to allow drift traveling of the toy in a narrow room (i.e., on a narrow floor space). Drift traveling refers to fish-tailing on a flat surface.

The Examiner contends that it would have been obvious to one of skill in the art to use the remote-controlled four-wheeled traveling toy according to Matsuzaka on a play board such as disclosed in Patch in order to allow the traveling toy according to Matsuzaka to be used indoors. This, however, is not an appropriate combination of references in that such a combination would defeat the intended purpose of the traveling toy according to Matsuzaka. First off, Matsuzaka is already

configured for indoor use, as is expressly noted in the English language abstract ("being run in a narrow room"). Thus, there is no motivation to use such traveling toy on a play board to facilitate indoor play. But more importantly, use of the traveling toy according to Matsuzaka on a play board would defeat its primary intended purpose, which is drift traveling on a flat surface. One would not be able to make a vehicle drift, which is fishtail sideways on a flat surface, if the traveling toy according to Matsuzaka were run on the play board according to Patch.

The Examiner admits that Matsuzaka and Patch do not teach a play board having formed therein a concave section with a size capable of fully receiving the front wheel or rear wheels and a depth allowing the toy to get out of the concave section by itself. But the Examiner contends that it would have been obvious to include such claim elements based on the teachings of Fors. Applicants respectfully disagree.

The vehicle used with the game board disclosed by Fors does not have a motor or other driving source and is not remotely controlled. On the contrary, as noted at col. 4, lines 36-39, movement of the vehicle is caused by the force of gravity and the movement of the play board by the player using his hands. Thus, the play board does not rest on an installation surface. It is a hand-held game. In Fors, the vehicle cannot get out of the concave section by itself. I can only get out of the concave section if the player moves the board with his or her hands to cause the force of gravity to get the vehicle out of the concave section, which would defeat the purpose of the game according to Fors, which is to trap the vehicle in the concave section. Since the concave section of Fors is an obstacle to prevent the traveling toy from going back onto the traveling surface, the depth of the concave section does

not allow the toy to get out of there and go back onto the traveling surface (see Figs. 6 and 7). In Fig. 6, since the body of the vehicle is tilted, the vehicle may get out of the concave section (a peripheral trough or channel or pit) by manually tilting the play board. In Fig. 7, the vehicle cannot get out of the concave section by any means, as described in lines 33 to 35, column 5. When the toy is fully received in the concave section in the central portion of the play board, the toy can merely move inside the concave section, but cannot get out of there even by manually tilting the play board. If the vehicle were able to get out of the concave section by itself, the concave section would cease to perform its function as an obstacle in the game. Fors simply cannot be relied upon to modify Matsuzaka and/or Patch to arrive at applicants' invention as claimed in claim 5. Claims 6-10, 20 and 21 depend from claim 5, either directly or through an intervening claim, and are thus patentable over such references for the same reasons as claim 5 is patentable over such references. Claim 19 includes the same relevant limitations as claim 5, and is thus also patentable over such references for the same reasons.

Finally, in the prior Office Action the Examiner rejected claim 10 under 35 U.S.C. §103(a) as being unpatentable over Matsuzaka, Patch, Fors and Derrah, U.S. Pat. No. 6,074,271. The Examiner contends that Fig. 23 of Derrah teaches a play board for use with remote control traveling vehicles having a horizontal surface along an outer edge. While this is true, the combination of Derrah with Matsuzaka, Patch and Fors does not result in a play toy system as claimed in claim 5, from which claim 10 depends. Accordingly, the rejection of claim 10 is improper.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is

determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 18-0160, our Order No. NIS-15982.

Respectfully submitted,

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